**TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING SECOND APPLICATION**

Docket Number (Optional)

530010-0009

In re Application of: Al Gilbertson

Application No.: 09/653,130

Filed: 08/31/2000

For: DEVICE FOR JUDGING SYMMETRY, BRIGHTNESS, AND EFFICIENCY OF LIGHT RETURN IN PRECIOUS STONES

The owner*, EightStar Diamond Company, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 09/578,058, filed on May 24, 2000, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

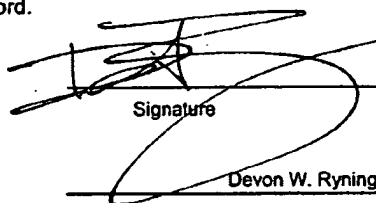
In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.


Signature

11/13/03
Date

Devon W. Ryning (48,579)

Typed or printed name

(206) 622-8484

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

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NOV 11 2003 TUE 03:14 PM MILLER, NASH

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P. 07/08



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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Eightstar

Application No./Patent No.: 07053,130 Filed/Issue Date: 02/14/2000

Entitled: DEVICE FOR JUDGING SYMMETRY, BRIGHTNESS, AND EFFICIENCY OF LIGHT RETURN IN PRECIOUS STONES

Assignee: Eightstar Diamond Company, Inc. a California corporation
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or

2. ☐ an assignee of less than the entire right, title and interest.
 The extent (by percentage) of its ownership interest is 100%
 In the patent application/patent identified above by virtue of either:

A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 013694, Frame 0037, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s) of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
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2. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.
 (NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08)

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

11/11/03
 Date
 (707) 793-7900
 Telephone number

Richard van Stenberg
 Typed or printed name
Richard van Stenberg
 Signature
 President
 Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to be (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 172 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the burden of this collection or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1689, Alexandria, VA 22313-1450. DO NOT SEND PAPER ON COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Nov 11 03 04:39p

EIGHTSTAR DIAMOND COMPANY 1-707-793-7976

P.2

NOV 11 2003 TUE 03:14 PM MILLER, NASH

FAX NO. 2066227485

P. 08/08



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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: N. Gierhenken
 Application No./Patent No.: 09/578,058 Filed/Issue Date: May 24, 2000
 Entitled: DEVICE FOR JUDGING SYMMETRY, BRIGHTNESS, AND EFFICIENCY OF LIGHT RETURN IN PRECIOUS STONES
 EightStar Diamond Company, Inc. California corporation
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
 2. ☐ an assignee of less than the entire right, title and interest.
 The extent (by percentage) of its ownership interest is _____ %
 In the patent application/patent identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 014107, Frame 0148, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

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 2. From: _____ To: _____
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 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

(NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08)

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

11/11/03
 Date
 (707) 793-7960

Telephone number

Richard von Sternberg

Typed or printed name

Signature

President

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to the (file) by the USPTO to process an application. Confidentiality is governed by 35 U.S.C. 121 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the burden of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (10-03)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003: Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$55.00)

Complete if Known

Application Number	09/653,130
Filing Date	08/31/2000
First Named Inventor	Al Gilbertson
Examiner Name	Layla G. Lauchman
Art Unit	2877
Attorney Docket No.	530010-0009

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit Account Number: 13-3571
Deposit Account Name: Miller Nash LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)				(\$)	

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)				(\$)	

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) Statutory Disclaimer Fee					55.00

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$55.00)

SUBMITTED BY

Name (Print/Type)	Devon W. Ryning	Registration No. (Attorney/Agent)	48,579	Telephone	2068/28484
Signature		Date	11/13/03		

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HGAU 2871

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Al Gilbertson
Assignee: EightStar Diamond Company, Inc.
Filing Date: 08/31/2000
Title: DEVICE FOR JUDGING SYMMETRY,
BRIGHTNESS, AND EFFICIENCY OF LIGHT
RETURN IN PRECIOUS STONES
Application Serial No.: 09/653,130

Attorney Docket No.: 530010-0009

CERTIFICATE OF MAILING

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

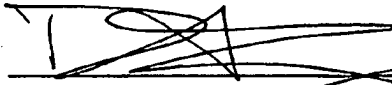
The following documents are today being deposited with the United States Postal Service "Express Mail Post Office to Addressee" (EV 309800559 US) service under 37 C.F.R. 1.10 in an envelope addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:

1. Transmittal Form PTO/SB/21;
2. Fee Transmittal for FY 2004 Form PTO/SB/17;
3. Check in the amount of \$55;
4. Response to Office Action;
5. Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending Second Application Form PTO/SB/25;
6. Statement Under 37 CFR 3.73(b) for Application Serial No. 09/653,130;
7. Statement Under 37 CFR 3.73(b) for Application Serial No. 09/578,058;
8. Certificate of Mailing; and
9. Itemized Return Receipt Postcard.

Signed at Seattle, Washington this 13th day of November, 2003

Respectfully submitted,

By:


Devon W. Ryning
Reg. No. 48,579
Miller Nash LLP
4400 Two Union Square
601 Union Street
Seattle, WA 98101
Phone: (206) 622-8484
Fax: (206) 622-7485

SEADOCS:165582.1



PTO/SB/21 (08-03)

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/653,130
	Filing Date	08/31/2000
	First Named Inventor	Al Gilbertson
	Art Unit	2877
	Examiner Name	Layla G. Lauchman
Total Number of Pages in This Submission	Attorney Docket Number	530010-0009

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input checked="" type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	Remarks Return Receipt Postcard, Certificate of Mailing, Statement Under 3.73(b) form for Application Serial No. 09/653,130; Statement Under 3.73(b) form for Application Serial No. 09/578,058, \$55 check	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Miller Nash LLP (Devon W. Rynning, 48,579)
Signature	
Date	11/12/03

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